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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/044,158	01/11/2002	Claude Jarakae Jensen	10209.388	1070

7590 10/02/2003

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EXAMINER
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PATTEN, PATRICIA A

ART UNIT	PAPER NUMBER
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1654

DATE MAILED: 10/02/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/044,158

Applicant(s)

JENSEN ET AL.

Examiner

Patricia A Patten

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 1-8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 September 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Claims 1-16 are pending in the application.

Claims 1-8 were withdrawn from consideration on the merits as being drawn to a non-elected invention in paper No. 12.

Claims 9-16 were examined on the merits.

### ***Drawings***

The drawings entered in Amendment B (preliminary amendment filed 9/30/02) are objected to because they contain attorney and application information and the text in figures 1 and 2 is not clear for printing. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### **INFORMATION ON HOW TO EFFECT DRAWING CHANGES**

#### **Replacement Drawing Sheets**

Drawing changes must be made by presenting replacement figures which incorporate the desired changes and which comply with 37 CFR 1.84. An explanation of the changes made must be presented either in the drawing amendments, or remarks, section of the amendment. Any replacement drawing sheet must be identified in the top margin as "Replacement Sheet" and include all of the figures appearing on the immediate prior version of the sheet, even though only one figure may be amended. The figure or figure number of the amended drawing(s) must not be labeled as "amended." If the changes to the drawing figure(s) are not accepted by the examiner, applicant will be notified of any required corrective action in the next Office action. No further drawing submission will be required, unless applicant is notified.

Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin.

### **Annotated Drawing Sheets**

A marked-up copy of any amended drawing figure, including annotations indicating the changes made, may be submitted or required by the examiner. The annotated drawing sheets must be clearly labeled as "Annotated Marked-up Drawings" and accompany the replacement sheets.

### **Timing of Corrections**

Applicant is required to submit acceptable corrected drawings within the time period set in the Office action. See 37 CFR 1.85(a). Failure to take corrective action within the set period will result in ABANDONMENT of the application.

If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings MUST be filed within the THREE MONTH shortened statutory period set for reply in the "Notice of Allowability." Extensions of time may NOT be obtained under the provisions of 37 CFR 1.136 for filing the corrected drawings after the mailing of a Notice of Allowability.

### ***Specification***

The Specification remains objected to for the repeated recitation of 'morinda citrifolia', while the accepted botanical nomenclature necessitates the capitalization of the genus 'Morinda'.

It is noted that The substitute specification filed 7/18/03 has been placed in the file but has not been entered because it does not conform to 37 CFR 1.125(b) and (c) for the following reasons. A marked-up version of the substitute specification has not

been filed, and the substitute specification does not contain a statement that the substitute specification contains no new matter.

Further, it has come to the Examiner's attention that the drawings filed 9/30/02 were not part of the original Specification. The Examiner assessed these drawings for new matter, and has deemed that Figures 1 and 3 introduce new matter. First, it is noted that in the 'Brief Description of the Drawings' Applicants refer to Figures 1-4, while there are only 3 Figures; Figures 1, 2, and 3.

Figure 1 contains a specific concentrating diagram which was not described in such detail in the Specification as originally filed. Although the Specification makes reference to Figure 1 as containing (actually, Applicants refer to the concentrating diagram incorrectly as 'Figure 3') 'one embodiment of a method of concentrating juice with reverse osmosis', none of the details in this diagram besides the title of the diagram were described in the Original Specification as filed. Further, Figure 3 contains details which were not described in the original Specification (i.e., particular amounts/percentages).

Although the phase properties of water as shown as part of figure 1 is accepted common knowledge and is not objected to herein *per se*, because Figure 1 contains the concentrating diagram, the entirety of Figure 1 is objected to. Applicant is required to remove the Figures containing new matter or to amend the Figures to delete the new

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matter. Because the Examiner accepts the water phase diagram, Applicants may wish to submit a new Figure 1 which omits the concentration diagram. Upon deleting the new matter from the drawings, Applicants should make changes to the Specification accordingly which conform to the new drawings; i.e., 'Brief description of the Drawings' as well as places in the Specification which refer to specific drawings.

### ***Claim Objections***

Claim 9 is objected to because of the following informalities:

Claim 9 recites 'slurry,-;' and 'sifting,-;'. It is unclear why there is a hyphen, a comma and a semi-colon used after these terms. This appears to be a minor typographical/grammatical error. Applicant is asked to amend this claim to include only one of a comma or a hyphen or a semi-colon after these terms.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 9-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Specifically, claim 9 states 'substantially pure water' and 'substantially non-aqueous portion'. Claim 11 also states 'substantially non-aqueous components'. Claim 15 recites 'substantially retains said phytochemicals', claim 16 recites 'substantially retains said flavor' and claim 17 recites 'substantially retains said volatile flavoring and phytochemical components'. The term 'substantially' in all of these claims is vague and indefinite in that the term is not defined in the Specification, and therefore the metes and bounds of this term cannot be readily determined. Does 'substantially retain' mean greater than 50%, or perhaps greater than 99%? The term is ambiguous and subjective lacking any definition of the term.

Claims 11-13 recite 'various non-aqueous components'. The Examiner cannot determine what Applicant means by this statement. Which components is the claim referring to? Because the claim states 'various' it is clear that Applicant has chosen to exclude a portion of the non-aqueous components of *M.citrifolia*. The Examiner cannot ascertain which non-aqueous components are excluded, and which remain. Therefore, the term is found indefinite. Applicant is asked to more clearly convey what components the claims mean.



Because claims 10 and 14 depend (either directly or indirectly) upon claim 9, these claims are also indefinite.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 9, 11, 15, 16 and 17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Specifically, claim 9 states 'substantially pure water' and 'substantially non-aqueous portion'. Claim 11 also states 'substantially non-aqueous components'. Claim 15 recites 'substantially retains said phytochemicals', claim 16 recites 'substantially retains said flavor' and claim 17 recites 'substantially retains said volatile flavoring and phytochemical components'. These phrases were not found in the Specification as originally filed, and it does not appear that Applicants contemplated these embodiments for the following reason:

These phrases do not 'flow freely' from the Specification. Although the Specification teaches that "...freeze concentration is capable of preserving almost all of the original chemical constituents, flavor, and aroma of fruit juices...", the Specification does not expressly recite the term 'substantially'. The recitation of 'substantially' in the newly amended claims does not mean 'almost all'. It is noted that although the term 'substantially' is vague and indefinite (please see rejection under 35 USC 112 Second paragraph *supra*), it is deemed that the term 'substantially' is a different scope than 'almost all' (whatever that scope may be). Therefore, these phrases are deemed new matter.

Applicant is asked to delete the new matter in order to overcome this rejection.

Claims are free of the art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Patricia Patten, whose telephone number is (703) 308-1189. The examiner can normally be reached on M-F from 9am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda Brumback, can be reached on (703) 306-3220. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306. Any inquiry of a general nature or relating to the status of this application or

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proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

September 25, 2003

A handwritten signature in cursive script, appearing to read "Patricia Patten".

Patricia Patten

PATRICIA PATTEN  
PATENT EXAMINER